

REMARKS

The present Amendment is in response to the Office Action mailed May 10, 2006.

Applicant affirms the election of Group I, claims 50-54, without traverse. Claims 55-59 are hereby withdrawn but may be refilled in a divisional application before the issuance of the present application.

In the Office Action, claims 50-54 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-13 of U.S. Patent No. 6,440,147, claims 1-19 of U.S. Patent No. 6,689,145, claims 1-24 of U.S. Patent No. 6,702,831, claims 1-18 of U.S. Patent No. 6,849,080, claims 1-18 of U.S. Patent No. 6,863,676, and claims 1-18 of U.S. Patent No. 6,764,495. Statutory disclaimers are filed herewith, restricting the term of any patent to issue on this application to the terms of the above-listed patents. Reconsideration and withdrawal of these rejections are, therefore, respectfully requested.

Claims 50-54 are rejected under 35 U.S.C. §102(e) as being anticipated by Burbank et al. (U.S. Patent No. 6,331,166). Claims 50-54 are rejected under 35 U.S.C. §102(b) as being anticipated by Heaven et al. (U.S. Patent 5,611,803). Claims 50-54 are rejected under 35 U.S.C. §102(b) as being anticipated by Wilk et al. (U.S. Patent No. 5,417,697). Claims 50-59 are currently pending.

Claim 50 has been amended to recite:

moving the tissue collection element to collect and encapsulate the tissue specimen such that the collected and encapsulated tissue specimen is disposed along the shaft and outside of the outer perimeter of the shaft, and

Burbank et al. do not teach any method that includes moving a tissue collection element to collect and encapsulate the tissue specimen such that the collected and encapsulated tissue specimen is disposed along the shaft and outside of the outer perimeter of the shaft. In Burbank et al., the tissue is

cut but is not collected and encapsulated. Even if the cutting elements have “webs between the cutting elements, to create a “sail” rather than distinct separate cutting elements”, as disclosed in Burbank et al. at col. 5, lines 16-21 (the passage noted by the Examiner), such webs or sails are not disclosed to encapsulate the collected specimen as recited in claim 50 or to isolate the collected specimen from the patient, as claimed in claim 52. Indeed, the plural cutting elements of Burbank et al. cannot encapsulate the specimen or isolate the specimen from the patient. See, for example, the cutting elements 72 of Figs. 11, 14, 12, 15 and 16, which are necessarily ineffective in encapsulating or isolating any tissue or specimen cut by such cutting elements – even if such plural cutting elements were webbed or provided with a “sail.” In fact, it is only the present application that teaches to encapsulate a cut specimen (as recited in claim 50) and to isolate the specimen from the patient (as recited in claim 52) along the shaft and outside the outer perimeter thereof. It is respectfully submitted, therefore, that the Burbank et al. reference cannot anticipate amended claim 50 or its dependent claims.

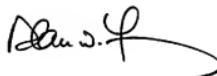
Turning now to Heaven et al. and Wilk et al., the Office will note that neither of these two references show or teach that the cut and encapsulated specimen “is disposed along the shaft and outside of the outer perimeter of the shaft”, as required by claim 50. In Heaven et al., the collected tissue is clearly disposed at the distal end of the shaft (delivery tube 38), and not “along the shaft” as required by claim 50 and not disposed “outside of the outer perimeter of the shaft”, as also required by claim 50. See, for example, Figs. 3-11B of Heaven et al. The Heaven et al. reference, therefore, cannot teach the claimed moving step. It is respectfully requested, therefore, that the anticipation rejection over the Heaven et al. reference be reconsidered and withdrawn.

Lastly, Wilk et al. reference do not teach a moving step wherein the tissue collection element is moved “to collect and encapsulate the tissue specimen such that the collected and encapsulated

tissue specimen is disposed along the shaft and outside of the outer perimeter of the shaft.” Indeed, note that the cut tissue, in Wilk et al., is disposed at the distal end of the shaft (endoscope insertion member 86) and not along the shaft and outside of the outer perimeter thereof, as required by claim 50. Also, note that claim 53 requires that the providing step be “carried out such that the shaft defines a longitudinal shaft axis and wherein the longitudinal shaft axis does not intersect the collected tissue specimen.” This is not the case in Wilk et al., in which the longitudinal axis of the endoscope insertion member 86 clearly intersects with the collected tissue specimen. See, for example, Figs. 3A-10 and associated written description in Wilk et al. Reconsideration and withdrawal of the §102 rejections over the Wilk et al. reference are, therefore, respectfully requested.

Applicants believe that this application is now in condition for allowance. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below and whatever is necessary to resolve such issues will be done at once.

Respectfully submitted,



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By: _____

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